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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,932	11/21/2001	Robert J. Sicurelli JR.	CONTINUATION-11-D1	4222
4988	7590	04/13/2004	EXAMINER	
ALFRED M. WALKER 225 OLD COUNTRY ROAD MELVILLE, NY 11747-2712			WILSON, JOHN J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/990,932

Applicant(s)

SICURELLI ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-36 and 38-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-36 and 38-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Renumbering of Claims***

The amendment of February 25, 2004 includes the same incorrect numbering as submitted before because there is no claim 65. The examiner has again renumbered claims 66-70 to be claims 65-69 respectively.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 64 and 65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure, as filed, does not teach a "tapered series of truncated conical section", and therefore, this limitation is held to be improper new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 57 and 59-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter

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which applicant regards as the invention. In claims 57, 59 and 61, "and core inelastic post" lacks proper antecedent basis within the claims. In claim 60, "dental reinforcement post" lacks proper antecedent basis with the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 33, 34, 38, 41, 53 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Reynaud et al (5328372). Reynaud shows a post having non-metallic and non-woven fibers 5 in a resin 4. All of the actual claimed structure being shown, the method step of not using a traction pulling force when forming is given no patentable weight. The fibers and resin are inherently flexible before being assembled and cured.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 35, 36, 40, 42-50, 54, and 56-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372). Reynaud teaches matching properties of the tooth. To match the flexibility is an obvious matter of choice in matching a known property of teeth, and further, because this limitation is as broad as there exists different flexibility among different teeth, it is held that such flexibility would be obvious to one of ordinary skill in the art in the tooth that the post is intended to be used with. The specific shape of the post used is an obvious matter of choice in shape to best match the canal. The type of fibers used is an obvious matter of choice in known materials to one of ordinary skill in the art.

Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) as applied to the claims above, and further in view of Al Kasem (5326264). Reynaud does not show using an opaque material. Al Kasem teaches using an opaque filler, column 18, line 19. It would be obvious to one of ordinary skill in the art to modify Reynaud to include the use of an opaque material as shown by Al Kasem in order to make use of known materials for best matching the tooth.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) as applied to the claims above, and further in view of Kennard (3903603). Reynaud does not show using a loop. Kennard teaches using a loop shape, column 2, lines 55-57. It would be obvious to one of ordinary skill in the art to

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modify Reynaud to include a loop shape as shown by Kennard in order to make use of art known shapes for better holding within a tooth.

Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reynaud et al (5328372) as applied to the claims above, and further in view of Weissman (5326263). Reynaud does not show an end shaped to direct light. Weissman shows an end shaped to direct light, Fig. 6. It would be obvious to one of ordinary skill in the art to modify Reynaud to include a shaped end as shown by Weissman in order to direct light. To shape the end by polishing is an obvious matter of choice in the process used to obtain a known structure to the skilled artisan.

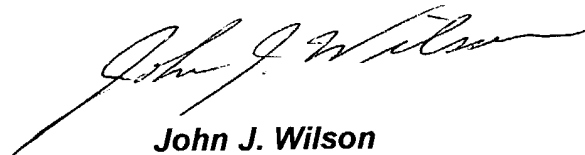
### ***Response to Arguments***

Applicant's arguments filed February 25, 2004 have been fully considered but they are not persuasive. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in cursive script, appearing to read "John J. Wilson".

**John J. Wilson  
Primary Examiner  
Art Unit 3732**

jjw

April 12, 2004

Fax (703) 872-9306

Work Schedule: Monday through Friday, Flex Time